

The ink contains the fluorinated surfactant, colorant and a vehicle. The composition can also contain a plethora of other materials, one of which could be an energy curable monomer, oligomer or mixture. As the Office Action acknowledges, Ylitalo fails to teach or suggest any solvent-soluble resin is present. The rejection therefore relies upon Subbaraman.

Subbaraman describes a moisture-free, non-pigmented ink “containing only solvents and solvent soluble resins and dyes that exhibit acceptable characteristics of opacity, contrast, adhesion and machine compatibility” in which the “differential solubilities of the resins in the solvent-blend is the prime moving factor of the opacifying action.” (Abstract). There is no teaching or suggestion in Subbaraman of the presence of an energy curable monomer, oligomer or mixture, and quite to the contrary, the Subbaraman composition is designed to cure by drying. See, e.g., column 3, line 23, and column 13, line 45 to column 14, line 3.

The Supreme Court in *KSR*, and subsequent cases by the Federal Circuit have made it clear that there must be some stated reason to extract a teaching from a secondary reference and incorporate it into the primary reference. There is no such reason here. Moreover, since Ylitalo’s composition may or may not contain an energy-curable material, there must be a reason to extract some teaching from Subbaraman and incorporate it into Ylitalo when the Ylitalo composition contains an energy-curable material.

Subbaraman employs a solvent-soluble resin in order to realize the optimum balance of adhesion and opacity in a composition which cures by drying, and the Office Action also makes reference to viscosity of the composition. While those may be a reason to incorporate the solvent-soluble resin in a composition which cures by drying, it does not

constitute a reason to incorporate such a resin in a composition which cures by a different mechanism, namely polymerization or cross-linking, and therefore requires the presence of a photoinitiator, such as the energy curable compositions of Ylitalo. See [0086].

A reason to use something in one reference is not, *ipso facto*, a reason to use it in a completely different set of circumstances. If there was a reason to use the material in the different type of composition, that reason must be stated. It has not been here.

Since no valid reason exists for extracting a solvent-soluble resin from Subbraraman (or any other reference for that matter) and incorporating it into an energy curable composition, it is respectfully submitted that the combination is improper and the rejection is untenable.

In view of the above remarks, applicant believes the pending application is in condition for allowance.

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Respectfully submitted,

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